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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,295	10/02/2000	Mathias Entenmann	12964.15	4137
27683	7590	06/19/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,295

Applicant(s)

MATHIAS ENTENMANN

Examiner

Daniel S. Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 9-19, 21-33 and 35-45 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5, 9-19, 21-33, 35-45 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt of the minor amendments filed February 06, 2006 is acknowledged.

### ***Response to Arguments***

2. Applicant's arguments filed February 06, 2006 have been fully considered but they are not persuasive. Rejections are maintained below.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The rejection of claims 1-5, 7, 9-19, 21-33, 35-43 are maintained. Applicant's arguments filed have been fully considered but they are not persuasive. Applicant has argued that the applied references are defective in establishing a prima facie case of obviousness and that the combination of Hultgren in view of Musa can not be applied to the rejected claims under 35 U.S.C. 103(a) because the combination of the cited prior art does not render obvious the subject matter of the claim(s) as a whole.

Firstly, it is respectfully submitted to applicant that in order to establish a prima facie case, the following three criteria must be met:

Art Unit: 3624

--Some suggestion or motivation by reference or general knowledge of one of ordinary skill in the art. In this case the primary reference, Hultgren, discloses a wireless cashless transaction method /system in that (among other wireless devices) uses a mobile phone in combination with a subscriber identification mobile CtS1M") card (see Hultgren, page 26), but fails to disclose that the card is a "smart" card with an ID code identifying it.

The secondary reference, Musa discloses the fact that the combination of a cell phone used in combination with a smart card is known within the art (see Musa, col. 2, 11. 45-59). The motivation given for the combination of references by the examiner was, that an artisan of ordinary skill at the time of the invention would have considered the modification a substitution of art equivalence inasmuch as both cellular phones in this aspect of the invention are relating to identification of the user"

-- There must be a reasonable expectation of success. It is respectfully suggested the applicant read the prior office action again where it states, There must be a reasonable expectation of success. "...an artisan or ordinary skill in the art would recognize the notoriously old and well known combination of a smart card and cell phone as a cost effective means of user identification." Furthermore, one of ordinary skill in the art would have sought out the smart card for providing the latest identification security technology for remote activation/deactivation devices (see Musa col. 1, 11. 36+).

--The prior art references must teach or *suggest* all the claimed limitations: It is respectfully submitted that the applicant carefully read over the primary and secondary references again in light of the previous office action of October 2, 2002 and in light of the claims presented to the

Art Unit: 3624

examiner at the time prior office action was mailed. The examiner maintains that the combination of references do teach or suggest to one of ordinary skill in the art all the limitations. The examiner also has provided reasoning for the combination of references for one of ordinary skill in the art within the previous office action. Since the examiner is under compliance with the criteria set forth above, it is maintained that the prima facie case is proper.

Secondly, it is respectfully submitted to the applicant that references are evaluated by what they suggest as a whole to one versed in the art, rather than their specific disclosure (see *In re Bozek*, 163 USPQ 545 (CCPA 1969)). New are also rejected below.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren in view of Musa. See explanation given above for claims

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DSF  
June 09, 2006

Daniel S Felten  
Examiner  
Art Unit 3624



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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3800